



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,808	01/26/2001	Michael M. Segal	SIMU-P01-003	8253

28120 7590 04/28/2005

FISH & NEAVE IP GROUP  
ROPES & GRAY LLP  
ONE INTERNATIONAL PLACE  
BOSTON, MA 02110-2624

EXAMINER
----------

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/770,808

Applicant(s)

SEGAL, MICHAEL M.

Examiner

Debra F. Charles

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Arguments***

1. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

A correlation module is a software application and therefore any software application that collects data is prior art to this invention.

Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,2,3,5, 6, 10, 14,15,16,18,19,20,23, 27,28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Hoff et al.(U.S.PAT. 6272536 B1) and Gilmour et al.(6115709).

Re claims 1, 6, 10, 14,19,20,23,27 and 28: van Hoff et al. disclose a system for directing content to an end user's computer located within a network, computer readable medium having instructions stored thereon for directing a computer to (Abstract, col. 3, lines 10-25), comprising

a data collection module for gathering information about a person and for storing the information within a protective zone located within the end user's computer and isolated from third parties(col. 4, lines 20-65),

And said data collection module, said data content module reside within said end user's computer(Abstract, col. 3, lines 10-25).

And end user's computer forwards a request for said content to a network server, and said network server delivers said requested content to said end user's computer in response to said request(Abstract, col. 3, lines 10-25, col. 4, lines 20-65).

van Hoff et al. disclose(s) the claimed invention except a data content module for maintaining identities of available data content wherein said identities contain parameters corresponding to said available data content, a correlation module for correlating said gathered information with said available data content to produce a set of content corresponding to said gathered information, and for directing said content to said end user. And said correlation module reside within said end user's computer.

However, in Abstract, col. 9, lines 20-67, col. 10, lines 45-55, col. 12, lines 15-40, thereof, Gilmour et al. disclose(s) data collection and analysis in a privacy-secure space with passive-private secure data collection. It would be obvious to one of ordinary skill in the art to modify the invention of van Hoff et al. based on the teachings of Gilmour et al. The motivation to combine these references is to ensure data collected remains secure and is associated with defined parameters, enhancing the efficiency of these targeted marketing techniques.

Re claims 2,3, 5, 15,16, and 18: van Hoff et al. disclose said gathered information pertains to medical information. And end user is a health care provider and said person is a patient. And said gathered information pertains to financial information(col. 3, lines 10-25, col. 4, lines 20-45,col.

11, lines 15-45, i.e. data and code is stated in the patent, however, the nature of the data would not be relevant to the invention's functioning here).

Re claim 29: van Hoff et al. disclose having instructions for creating a secure connection from the computer to a server on a data network, whereby the protective zone is extended to the server(col. 12, lines 50-67,i.e. secure channel).

4. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Hoff et al. and Gilmour et al. as applied to claim 3 above, and further in view of Snell et al.(U.S.PAT. 5431691A).

van Hoff et al. and Gilmour et al. disclose(s) the claimed invention except a patient diagnostic tool wherein said patient diagnostic tool interfaces with said data collection module to assist in gathering information about a person. However, in col. 1, lines 5-20, col. 6, lines 15-55 thereof, Snell et al. disclose(s) a diagnostic tool that helps monitor the medical patient. It would be obvious to one of ordinary skill in the art to modify the invention of van Hoff et al. and Gilmour et al. based on the teachings of Snell et al. The motivation to combine these references is to enhance the quality of data collected from the user.

5. Claims 8, 9, 11, 12,13,21,22,24,25, 26,30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Hoff et al. and Gilmour et al. as applied to claims 6,10,14, and 27 above, and further in view of Herz et al.(U.S.PAT. 5754938A).

van Hoff et al. and Gilmour et al. disclose(s) the claimed invention except third party server and delivering content; instructions for processing the available data content received from a server on a network to produce said targeted data content; and instructions for processing the available data content stored in a data content module to produce said targeted data content. However, in Abstract, Fig. 14, 15, col. 7, lines 5-45, col. 8, lines 40-65, col. 31, lines 20-67, col. 32, lines 40-55 thereof, Herz et al. disclose(s) a proxy server that forwards data upon request. It would be obvious to one of ordinary skill in the art to modify the invention of van Hoff et al. and Gilmour et al. based on the teachings of Herz et al. The motivation to combine these references is to enhance system functionality by making data transfer through the network align with business rules.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



VINCENT MILLIN  
SUPERVISORY PATENT  
TECHNOLOGY CENTER  
100

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra F. Charles  
Examiner  
Art Unit 3624

\*\*\*